



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,289	11/28/2000	David M. Bankers	L294.12-0010	7557

164 7590 08/12/2004
KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

EXAMINER

DEMICO, MATTHEW R

ART UNIT PAPER NUMBER

2611

DATE MAILED: 08/12/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,289

Applicant(s)

BANKERS ET AL.

Examiner

Matthew R Demicco

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 5/20/04. Claims 1-29 are pending. Claims 1, 8, 13, 15, 21, 22, 24, 28 and 29 are amended. The objections to the drawings and claims are hereby withdrawn in light of the amendment.

Response to Arguments

2. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,611,654 to Shteyn in view of U.S. Patent No. 6,768,127 to Bonomi et al.

Regarding Claim 1, Shteyn discloses a method of guest-selected recording of television programs in an entertainment system (Col. 2, Lines 49-67) having a head end and a guest terminals connected by a distribution system (See Figure 1). Shteyn discloses a plurality of end terminals (See Figures 3 and 4). Further disclosed is an electronic program guide from which content is selected (Col. 1, Lines 35-39 and Col. 3, Lines 56-

58). The provision of such a program guide on user equipment reads on the claimed transmitting a schedule of television programs from the head end to a guest terminal. Further, the user selects a program for recording and later viewing from the program guide. This reads on the claimed transmitting, from the guest terminal to the head end, program recording selection data representing a program selected by a guest for recording. The program is subsequently recorded (Col. 2, Lines 57-67) and streamed from the server to the client for play-out (Col. 4, Lines 15-18). This reads on the claimed creating a digital file representing the program selected, storing the digital file, playing back the program selected based upon the digital file representing the program selected and transmitting the program being played back to the guest terminal.

What is not disclosed, however, is a) transmitting a schedule of previously recorded television programs available for time-shifted viewing, b) updating the schedule of television programs to include the program corresponding to the digital file, c) transmitting the schedule as updated to the guest terminal and d) transmitting from the guest terminal to the head end, data requesting playback of the program selected for recording, based upon a selection of that program from the schedule as updated.

Bonomi discloses a media system for providing media sources (Col. 6, Lines 21-36). Bonomi further discloses the ability to store media content in a media storage device (Col. 8, Lines 40-51) to allow subscribers to record their own content (Col. 9, Lines 26-37, Col 19, Lines 41-48, Col. 21, Lines 19-22, Col. 21, Lines 35-67 and Col. 33, Lines 64-66). Bonomi further discloses transmitting a schedule of television programs available for viewing and recording (Col. 18, Lines 6-28, Col. 34, Lines 47-49 and Figure 15c) and

Art Unit: 2611

previously recorded television programs available for time-shifted viewing (Col. 22, Lines 13-65). Further disclosed is updating and transmitting the schedule of television programs (Col. 22, Lines 12-14 and Col. 34, Lines 46-49) to include the program corresponding to the digital files (Col. 21, Lines 57-61 and Col. 35, Lines 3-38). A user is then operable to request a program for playback based upon a selection of that program from the schedule as updated (Col. 35, Lines 47-49). Bonomi is evidence that ordinary workers in the art would recognize the benefits of using and updating an EPG to manage recording and playback of remotely recorded programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Shteyn with the EPG of Bonomi in order to allow a user to better locate, manage, and retrieve live and recorded programming from a single user-friendly interface.

Regarding Claim 2, Shteyn in view of Bonomi disclose a method as stated above in Claim 1. Shteyn further discloses the recording of TV broadcasts (Col. 1, Line 66). The server has a tuner (See Figures 1-3) to tune to a channel on which a program is carried. Shteyn further discloses storing the file on a server as stated above. The storage of such data on a server reads on the claimed encoding the program into a digital format to create a digital file as is well known in the art.

Regarding Claim 3, Shteyn in view of Bonomi disclose a method as stated above in Claim 1. Shteyn discloses recording a program at a selected time (Col. 2, Lines 57-59). In order to record a program at a specific time, a recording schedule must be maintained which uses the program recording selection data received.

Regarding Claim 4, Shteyn in view of Bonomi disclose a method as stated above in Claim 3. Since the data is recorded based on a schedule selected by the user as stated above, it is inherent that the creation of the digital file is based upon the recording schedule.

Regarding Claim 5, Shteyn in view of Bonomi disclose a method as stated above in Claim 1. It is inherent that the server must have some way of linking the person who requested the recording to the actual recording in order to play back the right program to the right person. This reads on the claimed association between the digital file and the identification of the guest terminal that provided the program recording selection data.

Regarding Claim 6, Shteyn in view of Bonomi disclose a method wherein the schedule of television programs is an interactive program guide as stated above in Claim 1.

Regarding Claim 7, Shteyn in view of Bonomi disclose a method as stated above in Claim 6. Shteyn further discloses that the program recording selection data is produced based upon a selection made on the EPG (Col. 3, Lines 56-57).

Regarding Claim 8, see Claim 1 above. Shteyn further discloses that the client may be a TV tuner (See Figures 1-4) in a hotel (Col. 2, Lines 46-67) and that the server stores and plays out the stored video to the client (Col. 4, Lines 15-18). Since the client is a television receiver in a hotel, this reads on the claimed converting, in response to the playback request data, the digitally stored program to television signals and transmitting the television signals to the guest terminal.

Regarding Claim 9, see Claim 2 above.

Art Unit: 2611

Regarding Claim 10, see Claim 5 above.

Regarding Claim 11-12, see Claims 3-4 above.

Regarding Claims 13-14, see Claims 6-7 above.

Regarding Claim 15, Shteyn in view of Bonomi disclose an entertainment system comprising a plurality of guest terminals, a distribution system connected to the terminals, and a digital content server for storing entertainment content in digital files and supplying to the system television signals based upon the digital files as stated above in Claim 8. Further disclosed is a receiver (See Figures 1-4). In a television receiver as the one disclosed by Shteyn, it is inherent that television programs on a plurality of channels are received and supplied to the system. Further disclosed is an encoder as stated above for converting the selected television program, which is inherently on one of the channels, to a digital file as stated above. The file is stored on a server as stated above. This reads on the claimed transferring the digital file to the digital content server for storage. The server also reads on the claimed computer that communicates with the guest terminals over the distribution system (See Figure 1) and provides them with information about the television programs (EPG as stated above) and controlling operation of the encoder based upon a selection by a guest of a program to be recorded as stated above.

What is not disclosed, however, is communicating information about previously recorded television programs available for time-shifted viewing and controlling operation of the digital content server based upon a selection by a guest of a previously recorded program for time-shifted viewing.

Bonomi discloses a media system for providing media sources (Col. 6, Lines 21-36). Bonomi further discloses the ability to store media content in a media storage device (Col. 8, Lines 40-51) to allow subscribers to record their own content (Col. 9, Lines 26-37, Col 19, Lines 41-48, Col. 21, Lines 19-22, Col. 21, Lines 35-67 and Col. 33, Lines 64-66). Bonomi further discloses transmitting a schedule of television programs available for viewing and recording (Col. 18, Lines 6-28, Col. 34, Lines 47-49 and Figure 15c) and previously recorded television programs available for time-shifted viewing (Col. 22, Lines 13-65). Further disclosed is updating and transmitting the schedule of television programs (Col. 22, Lines 12-14 and Col. 34, Lines 46-49) to include the program corresponding to the digital files (Col. 21, Lines 57-61 and Col. 35, Lines 3-38). A user is then operable to request a program for playback based upon a selection of that program from the schedule as updated (Col. 35, Lines 47-49). This reads on the claimed controlling operation of the digital content server based upon a selection by a guest of a previously recorded program for time-shifted viewing. Bonomi is evidence that ordinary workers in the art would recognize the benefits of using and updating an EPG to manage recording and playback of remotely recorded programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Shteyn with the EPG of Bonomi in order to allow a user to better locate, manage, and retrieve live and recorded programming from a single user-friendly interface.

Regarding Claim 16, Shteyn in view of Bonomi disclose a method as stated above in Claim 15. It is inherent that the recording system would be able to support more than

Art Unit: 2611

one guest's request at a time. This reads on the claimed encoder being an array including a plurality of tuners for tuning to the channels and an encoding device connected to each tuner.

Regarding Claims 17-18, see Claims 6-7 above.

Regarding Claim 19, Shteyn in view of Bonomi disclose a method as stated above in Claim 15. Shteyn further discloses a system that in response to a request from a guest terminal, the computer causes the digital content server to supply television signals based upon the digital file representing the selected program as stated above in Claim 8.

Regarding Claim 20, see Claim 3 above.

Regarding Claim 21, Shteyn discloses a method of providing guest-selected viewing of time-shifted television programs in an entertainment system as stated above. What is not disclosed, however, is transmitting from the head end to the guest terminal an interactive display of previously recorded television programs available for time-shifted viewing based upon the digital files stored. Bonomi discloses a method as stated above comprising transmitting from the head end to the guest terminal an interactive display of scheduled television programs available for viewing and previously recorded television programs available for time-shifted viewing based upon the digital files stored as stated above. Bonomi is evidence that ordinary workers in the art would recognize the benefits of using and updating an EPG to manage recording and playback of remotely recorded programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Shteyn with the EPG of

Art Unit: 2611

Bonomi in order to allow a user to better locate, manage, and retrieve live and recorded programming from a single user-friendly interface.

Regarding Claim 22, Shteyn in view of Bonomi disclose a method of providing time-shifted television programs in an entertainment system as stated above in Claims 1, 8 and 15.

Regarding Claim 23, see Claim 2 above.

Regarding Claim 24, Shteyn in view of Bonomi disclose an entertainment system as stated above in Claim 15.

Regarding Claim 25, see Claim 16 above.

Regarding Claim 26, see Claim 19 above.

Regarding Claim 27, Shteyn in view of Bonomi disclose a method as stated above in Claim 24. In this system, the computer receives a request for recording and builds a schedule as stated above. Since the computer also handles the recording and subsequently the encoding of the data, this reads on the claimed computer creating a recording schedule for the encoder.

Regarding Claim 28, Shteyn in view of Bonomi disclose a method of providing guest-selected viewing of time-shifted television programs as stated above.

Regarding Claim 29, Shteyn in view of Bonomi disclose a method of providing guest-selected viewing of time-shifted television programs as stated above. Shteyn further discloses that the system is operable to record TV broadcasts as stated above. It is inherent that TV broadcasts may include motion pictures and other television programs. This reads on the claimed digital files including a first group of files representing motion

Art Unit: 2611

pictures and a second group of files represented recorded television programs available for time-shifted viewings.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 5,805,763 to Lawler et al. discloses a program recording system with an EPG operable to record user selected programs at the head-end and display a program guide indicating currently available programming and previously recorded programming.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2611

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mrd

August 5, 2004



CHRIS GRANT
PRIMARY EXAMINER